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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,695	01/22/2004	Jorge L. Orbay	HAN-030	5249
7590	10/28/2005			
Gordon & Jacobson, P.C. 65 Woods End Road Stamford, CT 06905				
			EXAMINER AMARELD JR, ROBERT W	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 10/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,695

Applicant(s)

ORBAY, JORGE L.

Examiner

Robert W. Amareld, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9-12, 14-18, 28-35, 38-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-12, 14-18, 28-35 and 38-50 is/are rejected.
- 7) ☒ Claim(s) 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/27/04, 11/8/04, 1/28/05
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 37 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 37 recites the limitation "said plate" in part a of claim 37. There is insufficient antecedent basis for this limitation in the claim. It is suggested that "said plate" be changed to "said device". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 9-12, 14-18, 28-35, 37, 38, 40-50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Orbay (US Pat# 6508819). Orbay discloses a T-shaped plate (100) including relatively flat shaft (112) a generally flat head portion (110), being angled relative to the shaft (Column4, lines 5-8) and having an plurality/arrangement of threaded holes (106, column 3, lines 59-62) to receive threaded pegs with threaded heads(Figure 5, 5a). The head having a first and second surface

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areas, one surface area being larger than the other, which is obvious by the angled tip (124) shown in figures 2 and 3, the angle lengthening the surface, thereby increasing its area. The linearly arranged plurality of threaded holes (column 2, lines 40-46) define oblique axes in two dimensions (column 4, lines 19-37), which diverge from the lower surface of the head portion, in a fan-like shape (Figure 3, also column 4, lines 28-34), a fan-like shape being divergent in a medial-lateral and distal direction (column 4, lines 33-37), the holes may also lie along a curve (column 7, lines 22-23) and are preferably exactly four in number (column 4, lines 21-22). The shaft of the device including at least one non-threaded hole (102, column 4, line 52). The axes of the threaded holes are arranged to follow the contour of subcondral bone as shown in Figures 6 and 7 and are arranged to extend under the subcondral bone. (Column 5, lines 17-29), the plate and shaft portion also being shaped for placement at the radius (column 4, lines 65-67). A plurality of elements, being at least 3, may be attached to the head, obliquely, (column 5, lines 17-21) through the said plurality of threaded holes, and are non-converging (Figure 3) having threaded heads and/or threaded shafts.

Claims 37-39, 44, 46-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Chapman (US Pat # 5190544). Chapman discloses a rigid device (Fig 6 or Fig 29) having a head (47, 177) and shaft portion (45, 171), with a plurality of elements (89) which go through apertures (189, 191, 193) that "permit universal angulation of said screws" (columns 20-21, lines 64-68, 1-2) the universal angulation including oblique angles and non-converging angles, divergent angles in all directions. The plurality of elements are frictionally attached to the head portion upon attachment to

the bone, and are arranged in a substantially linear arrangement (Fig 29) which may be parallel to the shaft portion (Fig 29 or Fig 6) and generally medial-lateral across the head portion (Fig 29). The head portion may be angled upward as shown in Figure 30, while the head and shaft portion form a "t-shaped" configuration (Fig 29), where the shaft portion includes at least one hole (183).

Claims 37, 38, 40, 46 & 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Streli (US Pat# 4565193). Streli discloses a rigid device having a head portion and a shaft with at least one hole (Figure 2), and a plurality of elements (5) in a linear arrangement extending from the lower surface of the head, the elements being obliquely angled relative to each other (being at angle beta which is oblique), none of the four prongs converging toward another prong. The arrangement of prongs being generally medial-lateral across the head portion. The head portion is slightly angled upward as shown in Figure 1.

Claims 37, 41, 44, 46 & 48 are rejected under 35 U.S.C. 102(b) as being anticipated by Kyle (US Pat# 5749872). Kyle discloses a rigid device having an angled head (Figure 4, 44) portion and a shaft (40), having at least one hole, and a plurality of elements (38) extending from the lower surface of the head, the elements being obliquely angled relative to each other as shown in Figure 1, none of the elements converging toward another element. The elements are clearly in a curvilinear arrangement around the semi-spherical curved head portion, as shown in Figure 1, the placement of the screws about the head allowing the axis of the elements to be divergent both medial-laterally and distally as shown in Figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-12, 14, 16, 18, 28, 29, 31, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyle (US Pat# 5749872) in view of Wack (US Pat Appl# 10/100387, Pub# US2002/0156474) and Eberlein (US Pat Appl# 09/764936, Pub# US2001/0021851). Kyle discloses a generally flat head portion (44) defining a plurality of holes, including 4 holes with axes, (98) aligned along the smooth curve of the head (44) and a longitudinally extending relatively flat shaft portion (40) with at least one non-threaded hole, the shaft being angled relative to the head (Figure 4).

Kyle lacks threaded holes as well as oblique and divergent axes defining the holes. Wack provides the teaching of threading the holes with apertures 20 and 22 in Figure 3. Eberlein teaches a bore with a bushing, for use in conjunction with bone, which can be swiveled 360° and can be tilted at least 45° (claim 2) allowing for a plurality of bore axes directions including those which are oblique, divergent and non-converging in medial-lateral and distal directions in at least 2 dimensions relative to other bores or surfaces, including the contour of bone. It would have been obvious to one of ordinary skill in the art to use the threads, as taught by Wack with the tilting bore of Eberlein in combination with the plat of Kyle such that the threads and bore maintain

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the ability to provide bores with oblique divergent axes that can be threadably engaged by a fastener with a threaded head within the head portion of the plate.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9, 10, 14, 15, 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5 of U.S. Patent No. 6358250. Although the conflicting claims are not identical, they are not patentably distinct from each other because Pat# 6358250 claims a head and body with a non-threaded hole, as well as a plurality of threaded peg holes (exactly 4) with a plurality of axes that are divergent and oblique. The angles stated in claim 5 are inherently divergent and oblique.

Claims 37, 46, 48-50 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S.

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Patent No. 6767351. Although the conflicting claims are not identical, they are not patentably distinct from each other because Pat# 6767351 claims a rigid device with an angled head portion with a plurality of threaded pegs (elements) which are positioned at a "plurality of angles" (claim 1c) which anticipates oblique and non-converging angles and a body portion with at least one hole.

Conclusion

The Claims have been analyzed in comparison with all parent cases within the applications lineage and it has been found that each dependant claim within the present application (10/762695) contains newly claimed material not claimed in the parent cases. Therefore the effective filing date for each claim within the present application is maintained as the actual filing date of January 22, 2004

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Huebner (US Pat Appl# 10/716719, Pub# US2004/0102778), a T-shaped plate; Ganem (US Pat# 6022350), a bone fixing device.

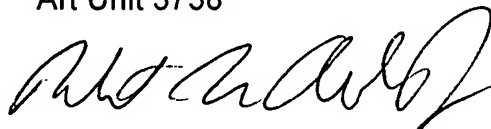
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Amareld, Jr. whose telephone number is 571-272-6170. The examiner can normally be reached on M-F 9am -5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert W Amareld, Jr.
Examiner
Art Unit 3738



RWA

BRIAN E. PELLEGRINO
PRIMARY EXAMINER



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